

Remarks

Currently pending in the application are Claims 1-31. In view of the following remarks, Applicants respectfully request reconsideration by the Examiner, and advancement of the application to allowance.

35 U.S.C. § 102 (b)

Claims 1-23 and 26-27 were rejected under 35 U.S.C. § 102(b) as being anticipated by either EP-0,692,516 or Spitler et al. (U.S. Pat. No. 6,166,109) and claims 1, 2, 4, 7-23, and 26-27 were rejected as being anticipated by Harrison et al. (U.S. Pat. No. 5,260,343).

To anticipate a claim, a reference must teach every element of the claim. *See MPEP § 2131; Richardson v. Suzuki Motor Co.*, 868 F. 2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (“the identical invention must be shown in as complete detail as is contained in the . . . claim.”).

EP-0,692,516 discloses a process for preparing thermoplastic double-foam using a blowing agent and microballoons containing a gas which is not specified. EP-0,692,516 does not disclose the use of thermally expandable microspheres containing a hydrocarbon. Since EP-0,692,516 does not identically disclose or describe the gas as being a hydrocarbon, EP-0,692,516 does not anticipate claims 1-23 and 26-27. *See MPEP § 2131.02; In re Meyer*, 599 F.2d 1026, 202 USPQ 175 (CCPA 1979)(To constitute anticipation, a “genus . . . [must] identically disclose or describe, within the meaning of §102, the species . . . since the genus would include an untold number of species.”). Applicants respectfully request the 102(b) rejection of claims 1-23 and 26-27 by EP-0,692,516 be withdrawn.

Spitler et al. issued on December 26, 2000 which is subsequent to Applicants international filing date. Therefore, the 102(b) rejection under Spitler et al. is moot. Applicants respectfully request the 102(b) rejection of claims 1-23 and 26-27 in view of Spitler et al. be withdrawn.

Finally, Harrison et al. (U.S. Pat. No. 5,260,343) discloses a process for producing integral skin polyurethane foams. *See U.S. Pat. No. 5,260,343 at col. 2, ls. 17-19.* An integral skin polyurethane foam is a thermosetting material formed by the application of heat and pressure that, once reacted, cannot be reformed. The integral skin polyurethane foam is prepared by reacting a polyisocyanate with an isocyanate reactive component in the presence of a catalyst, blowing agent(s) and other ingredients. *See id.* at col. 2, ls. 37-44.

In contrast to thermosetting materials, a thermoplastic material is a material that can be formed and reformed by the application of heat and cooling. Foamed thermoplastic polyurethanes are prepared by (i) reacting a polyisocyanate and isocyanate reactive component; and (ii) subsequently blowing this reacted material with at least one blowing agent.

Harrison et al. does not disclose foamed thermoplastic polyurethanes or methods for preparing thermoplastic polyurethanes as recited in independent claims 1, 19, 21 and 26. Therefore, Applicants respectfully request the 102(b) rejection of claims 1, 2, 4, 7-23, and 26-27 be withdrawn.

35 U.S.C. § 103

Claims 1-23 and 26-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Spitler et al. (U.S. Pat. No. 6,166,109) taken alone and Harrison et al. (U.S. Pat. No. 5,260,343) taken alone, or in view of Spitler et al. (U.S. Pat. No. 6,166,109).

Pursuant to MPEP § 2142, “[t]he examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.” To establish a prima facie case of obviousness, the following criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references when combined must teach or suggest all the claim limitations. *See* MPEP § 2142. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Spitler et al. is directed to syntactic rigid foam which is a thermosetting material. Similarly, Harrison et al. is directed to a process for preparing a foamed thermosetting material. Neither Spitler et al. nor Harrison et al. teach or suggest modifying its teachings to arrive at a process for preparing foamed thermoplastic polyurethanes.

Applicants have surprisingly found foaming thermoplastic polyurethane with thermally expandable microspheres containing a hydrocarbon and an additional blowing agent produces a low density thermoplastic polyurethane having improved skin quality and a reduced demould time. *See U.S. Pat. App. No. 09/890,067* at Tables 1 and 2. Furthermore, the process can be carried out at lower temperatures resulting in a better barrel stability. *See id.*

Accordingly, since Spitzer et al. and Harrison et al. do not teach or suggest Applicants claimed invention, Applicants respectfully request the 103(a) rejection of claims 1-23 and 26-27 be withdrawn.

Conclusion

In view of the foregoing remarks, Applicants respectfully submit that the application is now in condition for allowance, and respectfully request issuance of a Notice of Allowance directed towards the claims of the present application.

Should any fee be due in connection with the filing of this document, the Commissioner for Patents is hereby authorized to deduct the fee from Deposit Account No. 07-0153.

Respectfully submitted,



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